

REMARKS

Formalities

With this Amendment, Applicant cancels Claim 1 and adds new Claim 5. No new matter is added. Therefore, Claims 2-5 are all the claims currently pending in the present application.

In the current Office Action, the Examiner acknowledges Applicant's claim to foreign priority and the receipt of the certified copy of the priority document.

Drawings

The drawings stand objected to under 37 C.F.R. § 1.83(a) as allegedly failing to show every feature of the invention as specified in the claims. The Examiner asserts that "a glass rod holder for holding one side of a glass rod," as recited in Claims 3 and 4 is missing from the figures.

In response, Applicant notes that the glass rod holder 105 discussed in paragraph 28 of the specification is illustrated in Figure 3. Therefore, Applicant respectfully requests that the objection to the drawings be reconsidered and withdrawn.

Abstract

The Abstract stands objected to under MPEP §608.01(b) for exceeding 150 words in length. With this Amendment, Applicant amends the Abstract to 150 words or fewer. No new matter is added. Therefore, Applicant respectfully requests that the objection to the Abstract be reconsidered and withdrawn.

Claim Amendments and New Claim 5

With this Amendment, Applicant amends Claims 2 and 3 into independent form.

Applicant also adds new Claim 5 in order more fully to cover various aspects of Applicant's invention as disclosed in the specification. No new matter is added. Applicant respectfully requests the allowance of Claim 5.

Allowable Subject Matter

The Examiner indicates that Claims 2 and 4 contain allowable subject matter and would be allowed if rewritten into independent form including the limitations of the claims from which they depend. As noted above, Applicant amends Claim 2 into independent form. Claim 4 depends from Claim 2. Therefore, Applicant respectfully requests the allowance of Claims 2 and 4.

Claim Rejections

Claim 1 stands rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Ohmae et al., U.S. Patent No. 6,755,554 ("Ohmae"). As noted above, Claim 1 is cancelled.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Ohmae, in view of Inamoto, U.S. Patent No. 6,618,213 ("Inamoto"). Regarding this rejection, Applicant submits that the cited combination of references fails to teach or suggest at least "a glass rod holder for holding one side of a glass rod," as recited.

The Examiner acknowledges that Ohmae fails to teach or suggest a glass rod holder, as recited. Therefore, the Examiner relies on Inamoto to teach this limitation. (Office Action, p. 5).

Inamoto describes that the luminous flux density which has passed through the color filter is incident on a rod integrator 31 which homogenizes the luminous flux density. Applicant notes, however, that Inamoto fails to teach or suggest a glass rod holder for holding the rod integrator, as part of a fixing structure which holds the color wheel to the base of the projector. Regarding the “means for holding element 31,” as referred to by the Examiner, the Examiner appears to be asserting that a means for holding the rod integrator 31 is inherent to the disclosure of the system of Inamoto.

It is possible that where a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention.¹ However, evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”² “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”³ Even if the prior art reference could have equally been used or made with only two possibilities, a patent

¹ See *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981).

² *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*).

³ *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (*quoting Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))) (*emphasis in original*); see also *Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure.⁴

Therefore, even if it were assumed in this case that there was a holder for the rod integrator 31 of Inamoto, and that the holder *could* be incorporated into a fixing structure for a color wheel, there is no teaching or suggestion in Inamoto that such a possibility is a *necessity*. In fact, the placement of the rod integrator in the figures of Inamoto suggests that the rod integrator is located apart from the color wheel.

Therefore, in view of the above, Applicant submits that Claim 3 is patentable over the cited combination of references and respectfully requests that the rejection of Claim 3 be reconsidered and withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

⁴ See *Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

AMENDMENT UNDER 37 C.F.R. § 1.111
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